

**Amendments to the Drawings:**

Applicants have amended originally filed Figure 1. The amendments to the Figure are fully supported by Applicants' original written description and no new matter has been added. The attached sheets of drawings include the amendments. These sheets, which include Figure 1, replace the original sheet including Figure 1.

With respect to Figure 1, Applicants have amended the reference numbers identifying the applet 122 and the web server 120.

Attachment: Annotated Sheet, Replacement Sheet

## **REMARKS/ARGUMENTS**

The non-final Office Action of June 30, 2006, has been carefully reviewed and these remarks are responsive thereto. Claims 1-6, 8-9, and 11-30 have been amended. Claims 7 and 10 have been canceled without prejudice or disclaimer. Claims 31-40 have been added. Reconsideration and allowance of the instant application are respectfully requested. Claims 1-6, 8-9, and 11-40 remain pending.

Applicants have amended various portions of the Specification to maintain consistency between the original Figures and the original Specification. No new matter has been added. Applicants have amended claims 1-6, 8-9, and 11-30 to further clarify the scope of protection and/or to correct minor typographical errors. No new matter has been added with these amendments and no further search is required.

Dependent claims 2-20 and 22-29 have been objected to for informalities. Applicants have amended dependent claims 2-6, 8-9, 11-20 and 22-29 to recite “The system” and “The method” respectively.

### **Rejections under 35 U.S.C. §112**

Claim 19 stands rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for reciting the auxiliary verb “can.” Without acquiescing to the rejection, Applicants have amended claim 19 to remove the term “can.”

### **Rejections under 35 U.S.C. §102**

Claims 1-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gerace (International Publication No. WO 97/41673, hereinafter referred to as *Gerace*). Applicants respectfully traverse the rejection.

In order establish a prima facie case of anticipation under 35 U.S.C. § 102(b), each and every feature of the claim must be taught by the reference. *Gerace* describes a method and system for targeting of appropriate audiences based on psychographic or behavioral profiles of end users. (*Abstract*). *Gerace* uses agate information to determine the profile of a computer user, and in particular the behavioral or psychographic profile of a user. (p. 3, ll. 2-5). The

*Gerace* system includes a tracking and profiling member for recording user activity including presentation (format) preferences of users such as a User Object to track user actions in a history profiling table. (p. 3, ll. 8-19 and p. 4, ll. 23-25, and reference element program 31). For each and every user, the program 31 of the *Gerace* patent creates a user profile from the agate information viewing habits of the user. (p. 7, ll. 19-21). Advertisements are then displayed to users in accordance with the psychographic profile of the user. (p. 3, ll. 28-31). The system generates a custom Home Page, including a user's preferred agate information based upon the user profile. Under the *Gerace* system, user activity is monitored in order to create a user profile and advertisements are then shown based upon this user profile.

*Gerace* fails to teach or suggest every feature of Applicants' claim 1. Applicants' claim 1 recites, among other features "wherein no user profiling data is forwarded to the advertising server." As recited in Applicants' amended claim 1, at least one applet reads textual content displayed on the web browser and the advertising server compares the read textual content to keyword data to determine whether display an ad on the web browser. No data is forwarded to the advertising server. As described in Applicants' original written description, user privacy is a concern and tracking and generation of a user profile would not be desired, as opposed to the *Gerace* system. (See Applicants' original written description, paragraphs [10] – [11], [13], and [15]). The *Gerace* system requires generation of a user profile in order to generate a custom Home Page for a user. Under the *Gerace* system, advertisements are only displayed based upon the generated user profile.

Still further, the Action admits this requirement of the *Gerace* system. "The user's psychographic profile and demographic profile are collected from the user during a registration or an enrollment or sign-up process. Thereafter, the psychographic profile is constantly refined using the user's viewing habits (or exposure to content) and computer activity." (Action, p. 3). Applicants' claim 1 is patently distinct from *Gerace* for at least the reason that *Gerace* forwards user profiling data. Therefore, because *Gerace* fails to teach or suggest each and every feature of Applicants' amended claim 1, withdrawal of the present rejection is respectfully requested.

Claims 2-6, 8-9, and 11-20, which depend from claim 1, are allowable over the art of record for all the reasons given above concerning their respective base claim, and further in view

of the novel features recited therein. For example, Applicants' claim 5 recites, "said web browser is a Java™ enabled web browser," claim 6 recites, "said at least one applet is a Java™ applet," and claim 7 recites, "a servlet that facilitates communication between said at least one applet and said advertising server." No portion of *Gerace* teaches or suggests at least these features of Applicants' claims 5-7.

Applicants' amended claims 21 and 30 include similar language as recited above with respect to Applicants' claim 1. For at least similar reasons as recited above with respect to Applicants' claim 1, *Gerace* fails to teach or suggest every feature of Applicants' amended claims 21 and 31. As such, Applicants' claims 21 and 30 are allowable over the art of record. Applicants' claims 22-29, which depend from claim 21, are allowable over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

Claims 1-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Graham et al. (U.S. Patent No. 6,804,659, hereinafter referred to as *Graham*). Applicants respectfully traverse the rejection.

In order establish a prima facie case of anticipation under 35 U.S.C. § 102(e), each and every feature of the claim must be taught by the reference. *Graham* describes an internet target marketing method and system for distributing online advertising to viewers based upon the viewers' interests. (*Abstract*). As with the *Gerace* system described above, the *Graham* system uses a personal profile of a user. (Col. 6, ll. 7-11). The *Graham* system includes a concept comparator 106 that compares user concept output 20 from profile content recognizer 102 and advertiser concept output 22 from advertisement concept recognizer 104 to produce as an output a "best ad," 30, an advertisement targeted to the user of client browser 12a based on the content of the document, the user's interests and the content of the advertisements. (Col. 5, ll. 58-64). Advertisements are then displayed to users based on user's concepts of interest. (Col. 6, l. 17). Even the content of the document is based upon the user selectable concepts of interest. (Col. 7, ll. 50-53). As part of the process of analyzing a document to identify discussion corresponding

to one or more user selectable concepts of interest, reference in Graham is made to FIGs. 5-8. (Col. 8, ll. 46-51).

In description of FIG. 5, the Graham system utilizes an annotation agent 508 that depends on inputs by a user. The concepts of interest and other user-specific information are maintained in a user profile file 516. (Col. 11, ll. 23-31). Then, particular patterns in parsed text are determined by the contents of user profile 516 (col. 11, ll. 57-60), and a Bayesian belief network 700 uses user profile file 516 for source in order to ultimately output an advertisement (col. 12, ll. 52-55). Under the *Graham* system, a user profile file is created advertisements are then shown based upon this user profile file.

*Graham* fails to teach or suggest every feature of Applicants' amended claim 1. Applicants' claim 1 recites, among other features, "wherein no user profiling data is forwarded to the advertising server." As recited in Applicants' claim 1, at least one applet reads textual content displayed on the web browser and the advertising server compares the read textual content to keyword data to determine whether display an ad on the web browser. No data is forwarded to the advertising server. The *Graham* system requires generation of a user profile file in order to generate an advertisement for a user. Under the *Graham* system, advertisements are only displayed based upon the generated user profile file.

Applicants' amended claim 1 is patently distinct from *Graham* for at least the reason that *Graham* displays ads based upon a user profile file forwarded to an ads database. Therefore, because *Graham* fails to teach or suggest each and every feature of Applicants' amended claim 1, withdrawal of the present rejection is respectfully requested.

Claims 2-6, 8-9, and 11-20, which depend from claim 1, are allowable over the art of record for all the reasons given above concerning their respective base claim, and further in view of the novel features recited therein. For example, Applicants' claim 5 recites, "said web browser is a Java™ enabled web browser," claim 6 recites, "said at least one applet is a Java™ applet," and claim 7 recites, "a servlet that facilitates communication between said at least one applet and said advertising server." No portion of *Graham* teaches or suggests at least these features of Applicants' claims 5-7.

Applicants' amended claims 21 and 30 include similar language as recited above with respect to Applicants' amended claim 1. For at least similar reasons as recited above with respect to Applicants' claim 1, *Graham* fails to teach or suggest every feature of Applicants' claims 21 and 31. As such, Applicants' claims 21 and 30 are allowable over the art of record. Applicants' claims 22-29, which depend from claim 21, are allowable over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

Applicants' new claims 31-34, and 35, and 36, which depend from amended claims 1, 21, and 30, respectively, are patentably distinct over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein. Applicants' new claims 37-40 are fully supported by Applicants' original written description and figures. The art of record fails to teach each and every feature of Applicants' independent claim 37. Claims 38-40, which depend from claim 37, are patentably distinct over the art of record for at least the same reasons as their ultimate base claim.

**CONCLUSION**

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. If any additional required fees are or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

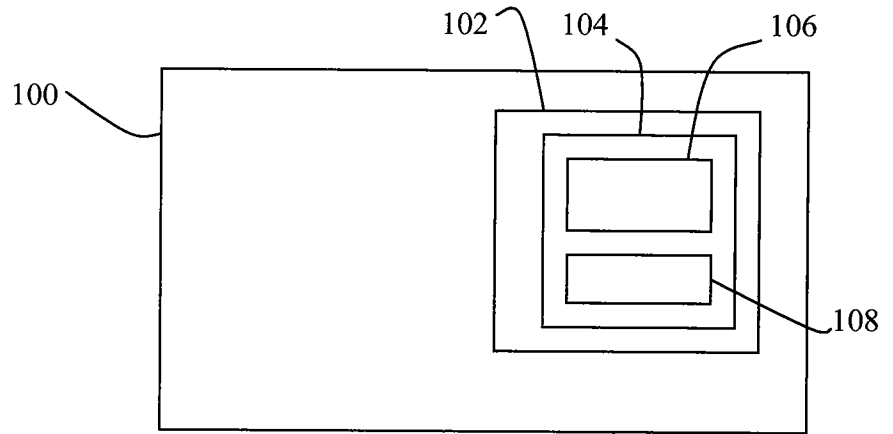
Respectfully submitted,  
**BANNER & WITCOFF, LTD.**

Date: September 20, 2006

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ANNOTATED SHEET



**Fig. 1**

